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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/406,321	09/27/1999	GUIDO M. SCHUSTER	99.365	1481
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EXAMINER

WARD, RONALD J

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 07/02/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,321

Applicant(s)

SCHUSTER ET AL.

Examiner

Ronald J Ward

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it repeats information given in the title. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

On page 6 line 19, the examiner suggests inserting a close parentheses after PID.

On page 7 line 10, the examiner suggests replacing the words "account telephone number the user profile telephone number" to the words --account telephone number to the user profile telephone number--, in order to clarify the intended meaning.

Appropriate correction is required.

Claim Objections

4. **Claim1** is objected to because of the following informalities:

The personal information device disclosed in line 1 of claim 1 is referred to as PID in subsequent claims. The examiner suggest writing --(PID)-- after the words "personal information device" to clarify the meaning of PID in subsequent claims.

On line 10 of claim 1, the examiner suggests replacing the words "account telephone number the user profile telephone number" to the words --account telephone number to the user profile telephone number--, in order to clarify the intended meaning.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 4**, the recitation, "a gateway locator to locate a user gateway closest to the user telephone number," is unclear since the dimensional units of the objects of the comparison are incompatible. That is, the first unit of measure is "closeness" implied by the word "closest" which would logically be in meters or miles while the second unit of measure is a telephone number, which does not lend itself easily to any form of measurement. Therefore, it is not clear how one would conduct a measurement of closeness to a telephone number. The examiner suggests substituting the word --telephone-- for the phrase "telephone number" on lines 2-3 of claim 4, to clarify the apparent intent of this claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2685

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. (PCT Number WO 99/12365) in view of Fuentes (U.S. Patent Number 5,960,340).

As to **claim 1**, Hyllander et al. disclose a personal information device used for controlling telephone service, referred to as a mobile subscriber station (8) in Figure 2. The mobile subscriber station (8) disclosed by Hyllander et al. comprises:

- a user interface comprising a display and a user input device (inherent to a mobile station having Short Message Service capability as disclosed by Hyllander et al.)

- a user profile having a telephone number entered by a user (see page 4 lines 6-13)

- a communications function to establish a data communications channel over a wireless network to a telephony control server, the telephony control server containing the user's telephony account; (see page 4 lines 6-13)

- an account update function to send a message over the data communication channel to the telephony control server, the message containing the user profile telephone number (see page 4 lines 12-13).

Hyllander et al. fail to explicitly recite an account update function wherein a message sent to the telephony control server contains a request to set the user's telephony account telephone number to the user profile telephone number.

In an analogous art, Fuentes discloses, in Figure 1, a wireless mobile unit (1) which has an account update function wherein a message sent to the universal telephone number service (52) contains a "change request for a universal telephone number service" (see col. 4 lines 53-

Art Unit: 2685

54). The request comprises a “message [that] includes the directory number of the mobile unit” (see col. 4 lines 57-58). Fuentes also refers to the directory number as a telephone number (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hyllander et al.’s personal information device to request a change of the user profile telephone number in a telephony control server, as taught by Fuentes. One of ordinary skill in the art would have been led to make this modification because wireless mobile devices often change locations and require registration with the local telephony control server in order to place and receive calls using the desired telephone number, as taught by Fuentes (see col. 1 lines 31-34).

As to **claim 3**, Hyllander et al. disclose a telephony control server referred to as telephony/internet server (11) in Figure 2. The server comprises:

- a network interface operable to provide data connectivity with a user accessible via a wireless network (see page 3 lines 31-33);

- an accounts program to access a plurality of user accounts (see page 5 lines 10-12),

- a connection signaling function to receive a call message from the user and to establish a telephone connection between the user telephone number and a callee telephone number contained in the call message (see page 5 lines 5-8);

- the connection signaling function operable to initiate a telephone call having at least a portion of the telephone call connected via the data network (see page 5 lines 5-8).

Hyllander et al. fails to explicitly recite that the accounts program is operable to receive a message to set a user telephone number, each user account containing a telephone number entry,

the accounts program being operable to set the telephone number entry in response to the message.

In an analogous art, Fuentes discloses, in Figure 2, a universal telephone number service having an accounts program that confirms receipt and completion of a “change request for a universal telephone number service” (see col. 4 lines 53-54). The request comprises a “message [that] includes the directory number of the mobile unit” (see col. 4 lines 57-58). Fuentes also refers to the directory number as a telephone number (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the accounts program of Hyllander et al.’s telephony control server to be operable to receive a message to set a user telephone number, each user account containing a telephone number entry, the accounts program being operable to set the telephone number entry in response to the message, as taught by Fuentes. One of ordinary skill in the art would have been led to make this modification because wireless mobile devices often change locations and require registration with the local telephony control server in order to place and receive calls using the desired telephone number, as taught by Fuentes (see col. 1 lines 31-34).

9. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. in view of Fuentes as applied to claim 1 above, and further in view of Moon et al. (U.S. Patent Number 6,075,992).

The combination of Hyllander et al. and Fuentes discloses everything as applied to claim 1 above. In addition, Hyllander et al. disclose a contacts application operable to store a plurality of contact entries (see page 5 lines 22-27), each entry comprising a contact telephone number (equivalent to address list number disclosed on page 5 line 22), the contacts application operable

Art Unit: 2685

to send the contact telephone number over the data communications channel to the telephony control server with a message to call the contact telephone number (see page 6 lines 15-25). However, Hyllander et al. fail to explicitly recite that the contacts application is operable to display a plurality of contact entries.

In an analogous art, Moon et al. discloses a portable intelligent device having a contacts application operable to display a plurality of contact entries (see Figure 4, also see col. 4 lines 60-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contacts application of Hyllander et al.'s personal information device to be operable to display the plurality of contact entries stored in the device, as taught by Moon et al. One of ordinary skill in the art would have been led to make this modification because such personal information managers are well known in the art (see col. 4 line 67 – col. 5 lines 1-3 in Moon et al.).

10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. in view of Fuentes as applied to claim 3 above, and further in view of Wiedeman et al. (U.S. Patent Number 5,448,623).

The combination of Hyllander et al. and Fuentes disclose everything claimed as applied to claim 3 above, but fail to explicitly recite the telephony control server having a gateway locator function to locate a user gateway closest to the user telephone and to locate a callee gateway closest to the callee telephone.

In an analogous art, Wiedeman et al discloses a wireless telephone system having a network coordinating gateway, which “selects an Active Gateway, which will handle all calls to

Art Unit: 2685

and from the user by a system selected method (such as gateway closest to user)” (see col. 6 lines 25-29). Thus, the network coordinating gateway inherently has a gateway locator to locate a user gateway closest to the user telephone and to locate a callee gateway closest to the callee telephone, wherein its connection signaling function initiates a connection between the user gateway and the callee gateway.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephony control server of Hyllander et al. to further comprise a gateway locator as described by Wiedeman et al. One of ordinary skill in the art would have been led to make this modification in order to reduce long distance transmission costs as known in the art.

11. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. in view of Fuentes, and further in view of Moon et al. It is considered that the combination of Hyllander et al., Fuentes, and Moon et al., as applied above to the system of claims 1-3, produces the method comprising the steps as claimed.

12. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. in view of Fuentes, and further in view of Moon et al. It is considered that the combination of Hyllander et al., Fuentes, and Moon et al., as applied above to the system of claim 2, produces the method comprising the steps as claimed.

13. **Claim 7**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Hyllander et al. in view of Fuentes and Moon et al, and further in view of Wiedeman et al. The combination of Hyllander et al., Fuentes, and Moon et al. disclose everything claimed as applied to claim 6 above. In addition it is considered that the modified system of Hyllander et al., Fuentes, and

Art Unit: 2685

Wiedeman et al. as applied above to the system of claim 4 above, produces the method comprising the additional step as claimed.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

As to **claim 4**, Dent (U.S. Patent Number 5,894,473) discloses a communication system wherein digitally compressed speech undergoes a "final conversion to... analog voice waveforms ... in a so-called mobile communications Gateway exchange, preferably the Gateway nearest the calling or called PSTN subscriber" (see col. 20 lines 1-5). The conversion is "performed nearer the terminal destination of the information in order to reduce long-distance transmission costs" (see col. 19 line 67 - col. 20 line 1).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald J. Ward whose telephone number is (703) 305-5616. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2685

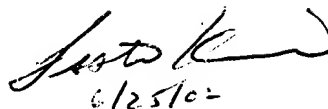
or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

RJW

June 24, 2002



6/25/02
LESTER G. KINCAID
PRIMARY EXAMINER